

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

FRANCO ET AL.

APPLICATION NO: 7,344,860

CONFIRMATION NO.: 3765

ISSUED: MARCH 18, 2008

FOR: POLYNUCLEOTIDE ENCODING A NOVEL HUMAN

P2X7 SPLICE VARIANT, HBMYP2X7v

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P.O. Box 1450  
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SUPPLEMENTAL PETITION TO CORRECT PATENT TERM ADJUSTMENT  
PERIOD  
IN GRANTED PATENT 7,344,860 under 1.705(D)

Sir/Madam:

This is a Supplemental Request for reconsideration of the patent term adjustment for the captioned patent. Applicant's previous request of March 13, 2008 has not yet been granted.

Statement of the Facts

As required under 37 C.F.R. § 1.705(b)(2), Applicant provides the following statement of the facts involved.

The patent term adjustment history from PAIR shows a USPTO delay of 560 days and Applicant's delay of 69 days. These days were calculated as follows:

USPTO Delay:

10-17-2006	Mail Restriction Requirement	502 days
03-18-2008	Patent Issue Date	<u>58 days</u>
		560 days

Applicants' Delay:

11-29-2006	Information Disclosure Statement	13 days
04-12-2007	Information Disclosure Statement	<u>56 days</u>
		69 days

USPTO Delay Corrected:

03-18-2008	PTA 36 Months	351 days
10-17-2006	Mail Restriction Requirement	<u>502 days</u>
		853 days

Applicant's Delay (Corrected):

11-29-2006	Information Disclosure Statement	13 days
04-12-2007	Information Disclosure Statement	<u>0 days</u>
	Total Applicant Delay	13 days

However, as indicated below, the period of USPTO delay for calculating the patent term adjustment should be 853 days (351 days plus 502 days) minus an Applicant delay of 13 days, resulting in a patent term adjustment of 840 days.

35 U.S.C. § 154(b) provides for adjustment of patent term due to certain delays of the USPTO. This includes the "A period" of 35 U.S.C. § 1.54(b)(1)(A) (concerning failure of the USPTO to comply with deadlines enumerated therein) and the "B period" of 35 U.S.C. § 1.54(b)(1)(B) (concerning failure of the USPTO to issue a patent within 3 years of filing).

In *Wyeth v. Dudas* (2008 WL 4445642 (D.D.C. September 30, 2008), the United States District Court of the District of Columbia rejected the USPTO's view<sup>1</sup> that any administrative delay under the "A period" (35 U.S.C. § 154(b)(1)(A) period) overlays any 3-year maximum pendency delay under the "B period" (35 U.S.C. § 154(b)(1)(B) period) (i.e., that applicant gets credit for "A period" or for "B period," whichever is larger, but never "A period" + "B period"). Rather, the *Wyeth* court held that the "A period" (35 U.S.C. § 1.54(b)(1)(A)) and the "B period" (35 U.S.C. § 1.54(b)(1)(B)) overlap *only* if they occur on the *same calendar day or days*. In view of the *Wyeth* decision, Applicant submits this request for reconsideration of the patent term adjustment period.

In the instant case, all of the "A period" (35 U.S.C. § 154(b)(1)(A) period) and "B period" (35 U.S.C. § 154(b)(1)(B) period) do not occur on the same calendar day or days. In particular, the 351 day USPTO delay occurring in the "B period" three years after the patent application was filed (beginning April 2, 2007 and ending on the issue date of March 18, 2008) does not overlap with the 502 day USPTO delay occurring in the "A period" (beginning June 02, 2005 and ending October 17, 2006). The 58 day USPTO delay in the "A period" beginning on January 20, 2008 and ending on March 18, 2008 does overlap with the "B period" and therefore will not be added to the 351 day "B period" delay."

Accordingly, in view of *Wyeth*, Applicant is entitled to the combination of the "A period" (502 days) and the "B period" (351 days), minus the Applicant delay of 13 days, which results in a patent term adjustment of 840 days. Applicant requests reconsideration of the patent term adjustment period.

The patent is not subject to any terminal disclaimer that would impact such a correction. In addition, Applicants believe there are no additional circumstances during the prosecution of the application that would constitute a failure to engage

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<sup>1</sup> See, 69 Fed. Reg. 34238 (2004).

in reasonable efforts to conclude processing or examination of such application as set forth in 37 C.F.R. § 1.704.

Timeliness of this Request


As this request is being filed within two months of the patent's issue date, it is timely under 37 C.F.R. § 1.705(d).

Request Fee

As required under 37 C.F.R. § 1.705(b)(1), please charge the fee prescribed in 37 C.F.R. § 1.18(e) to Deposit Account No. 19-3880 in the name of Bristol-Myers Squibb Company. Please charge any additional fees, or credit any overpayment, to the same account.

Respectfully submitted,

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